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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,232	01/16/2001	Takehiro Yoshida	862.C2092	9935
5514	7590	08/25/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			GRANT II, JEROME	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/759,232	<b>Applicant(s)</b> YOSHIDA, TAKEHIRO	
	<b>Examiner</b> Jerome Grant II	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10/6/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,9,11-13 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 3,7,10 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-28-2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### Detailed Action

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 8, 9, 11-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Monroe.

With respect to claim 1, Monroe teaches a communication method (performed by apparatus 180) for selectively (via switch 46) performing real-time facsimile communications via Internet Network 14, and facsimile communication without the Internet (network 22); wherein a communication parameter (type of protocol chosen for example) T.30 for non Internet Fax and T.38 for Internet fax.

With respect to claims 2 and 9, T.30 and T.38 are inherently different protocols and transmit at different rates based upon the detected rate sent in the DCS signal.

With respect to claims 4 and 11, this limitation is addressed by Monroe regarding the teaching that determination is made by switch 456 of circuit 180, see figure 5.

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With respect to claims 5 and 12, a person at PC 10 may designate Internet Fax communication, hence the parameter will be set when for 26 engages with an outside fax communicating over the T.38 protocol.

With respect to claims 6 and 13, based on the configuration of Monroe, the PC 10 is connected to the Internet Fax network.

With respect to claim 8, Monroe teaches a communication apparatus capable for real-time communication via the Internet, comprising: communication unit 180 adapted to perform communication; and changing means (control means as shown by figure 5) for changing a communication parameter used by said communication unit, based on whether the real-time facsimile communication without the Internet is to be performed. Internet is performed over network 14.

With respect to claim 15, Monroe teaches a compute readable memory CD ROM for holding a communication program, (software, see col. 3, lines 63-67) for selectively executing real-time facsimile communication via the Internet or the facsimile communication without Internet performance.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monroe in view of Iizuka.

Monroe teaches all of the subject matter upon which the claim depends. What is not specifically taught is the facsimile communication is based on ITU – T Recom. T.38.

What Monroe fails to explicitly explain is the specific use of the T.38 recommendation.

Iizuka teaches the specific use of the T.38 recommendation for real-time fax communication.

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Since, Monroe and lizuka are both directed toward the facsimile of e-mails over the Internet, the purpose of using the T.38 recommendation, as the standard, is obvious to anyone of ordinary skill that the above standard is that used for submitting e-mails by fax communication over a network.

Since, lizuka clearly teaches the use of the T.38 protocol in e-mail communications during a fax communication, it would have been obvious that the fax communication described by Monroe is to be performed over the same network giving that the T.38 is the industry standard.

3.

### **Claims Objected As Containing Allowable Matter**

Claims 3, 7, 10 and 14 are objected to as containing allowable matter.

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4. **Examiner's Remarks**

The applicant's remarks have been considered and are persuasive. The previous rejection is withdrawn in view of new art applied against the claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thur. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on 571-272-7463. The fax phone number for the organization where this application or proceeding is assigned is 571-272-7463.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEROME GRANT II  
PRIMARY EXAMINER